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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,675	09/26/2005	Valerie De la Poterie	08048.0067	3249
22852	7590	02/01/2011		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1619	
			MAIL DATE	DELIVERY MODE
			02/01/2011 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/526,675

Applicant(s)

DE LA POTERIE ET AL.

Examiner

JYOTHSNA A. VENKAT

Art Unit

1619

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-53, 60-62 and 65-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-53, 60-62 and 65-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/26/10
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of amendment filed on 11/16/10, IDS and remarks filed on 10/26/10. Claims 63 and 64 are cancelled as per applicants' amendment dated 11/16/10.

Status of claims

Claims 1-41, and 63-64 are cancelled. Claims 88-119 are withdrawn from consideration as being drawn to non-elected invention (election with traverse dated 6/15/09). Claims 54-59 are withdrawn from consideration as being drawn to non-elected species (election with traverse dated 6/15/09).

Claims 42-53 and 60-62, and 65-87 are examined in the application. The elected species is carnauba wax drawn to " wax".

In view of the amendment, incorporating microwax, all the 103 rejections are hereby withdrawn.

The following new grounds of rejection are necessitated by the amendment.

Claim Rejections - 35 USC § 103

Claims 42-53 and 60-62, 65-73 and 75-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of (U. S. Patent 6,264,933 or EP 1013256) and (U. S. Patent 6,946,123 or EP 1,201,222).

EP 1, 013,256 is the European counterpart to US 6,264,933. EP 1, 013,256 and US 6,264,933 appear to have identical disclosures, for simplicity they will together be referred to hereinafter as " 933". While any reference hereinafter to column and line numbers will be based upon the US patent disclosure, such reference should be interpreted as including the corresponding disclosure of the aforementioned EP counterpart.

EP 1, 201,222 is the European counterpart to US 6,946,123. EP 1, 201,222 and US 6,946,123 appear to have identical disclosures, for simplicity they will together be referred to hereinafter as "123". While any reference hereinafter to column and line numbers will be based upon the US patent disclosure, such reference should be interpreted as including the corresponding disclosure of the aforementioned EP counterpart.

Claim analysis

Claim 42 recites the limitation "that the total volatile content is less than or equal to the solids content of the composition".

Specification at page 4, penultimate paragraph defines, **the term "solids content" refers to the content of non- volatile matter".**

Patent '933 discloses waxes, fillers, film forming polymers, thickeners, auxiliary film – forming polymers, and all these belong to "solids content" and the addition of the weight percent of all these ingredients (higher weight percent) **meet the limitations of claims 1-4.**

The weight percent of wax is 2-40 %; the weight percent of film forming polymer is 0.05-10%; the weight percent of filler is 0.5-10%; the weight percent of thickener is 0.5-10%; the weight percent of auxiliary film forming polymer is 0.5-15%; the weight percent of pulverulent compound is 0.01-30% (claims 43-45).

See col.6, ll 6-10 for weight percent of volatile oil which is 35-75 % (claims 45-47) and see col.5, line 59 through col.6, ll 11-19 (claims 48-51); see col.7, ll 10-30 (claims 52-53, 60-63); **the wax weight percent is 2-40%**, see examples for Vinyl acetate/allyl stearate and see col.8, ll 14-20 for claims 65-71, see the weight percent of the film forming polymer at col.8, ll 43-45, which is 0.5 % to 15 % (claims 72-73) see col.4, ll 17-29 for water or water soluble

solvent and the weight percent is 1-35 % (claims 75-78); see col.4, ll 5-10 for film forming polymer (claim 79); see col.9, line 15 for dyestuff (80); see col.5, ll 1-39 for filler (claim 81); and see col.9, ll 25-30 (claim 82); see col.6, line 19 through col.7, line 7 for non volatile oil (claim 83). Thus patent teaches all the limitations claimed and therefore the mascara compositions of patent would also have the claimed property claimed in claims 84-87.

The difference between patent '933 and instant application is patent does not teach the new limitation , which is microwax in the form of small particles.

Patent '123 teaches film-forming cosmetic compositions. Patent '123 at col.10, ll 55-65 teaches that the compositions can comprise additional wax in the form of particles and the particle size is 1 micron. This meets limitation of claim 42 for microwax. Patent '123 at paragraph bridging cols 10-11 explicitly teaches that the additional wax makes it possible to obtain thick application of make-up on the eyelashes and teaches that the waxes can be those cited before. See col.8, line 50 through col. 9, line 62 for various waxes. Patent ' 123 at col.10, ll 1-4 teaches the amount of microwax and this is from 0.1 to 50% by weight. Patent at col.9, ll 60-62 teaches the combination of waxes and this includes carnauba wax, bees wax and candelillia wax. Patent under example 2 drawn to mascara teaches the concept of having wax and also the microwax and the total weight percent is 41.5 % and this is within the total weight percent claimed in claim 42.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions taught by patent '933 using wax, film former, non-aqueous phase, additional film former, dyes, fillers, non-volatile oil and add the micro wax taught patent '123 which teaches using combination of wax and microwax in analogous cosmetic

compositions drawn to making up keratin fibers (mascara). One of ordinary skill in the art would be motivated to prepare the compositions of patent '933 and add microwax in the form of small particles with the reasonable expectation of success that the compositions when applied to keratin fibers not only exhibit curling of the eyelashes and are water resistant but also the compositions can thicken the eyelashes. It is beneficial to consumer having on single product that is water resistant and at the same time curl the eyelashes and also thicken the eyelashes.

Claim 74 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of (U. S. Patent 6,264,933 or EP 1013256) and (U. S. Patent 6,946,123 or EP 1,201,222) as applied to claims 42-53 and 60-62, 65-73, 75-87 above, and further in view of U. S. Patent 5,959,009 ('009).

Patents '933 and '123 does not teach the limitation of claim 74. However patent '009 teaches mascara water proofing compositions using volatile oil and not using water. See example 1.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions taught by patent '933 using wax, film former, non-aqueous phase, additional film former, dyes, fillers, non-volatile oil and add the micro wax taught patent '123 which teaches using combination of wax and microwax in analogous cosmetic compositions drawn to making up keratin fibers (mascara) and prepare compositions without water taught by patent '009 which uses volatile oil, film forming former expecting the mascara compositions exhibit good curling as well as water proof without using water taught by patent '009. One of ordinary skill in the art would be motivated to prepare the compositions of patent '933 and add microwax in the form of small particles and prepare compositions without water

with the reasonable expectation of success that the compositions when applied to keratin fibers not only exhibit curling of the eyelashes and are water resistant but also the compositions can thicken the eyelashes. It is beneficial to consumer having on single product that is water resistant and at the same time curl the eyelashes and also thicken the eyelashes. This is a prima facie case of obviousness.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT WAX can be reached on 571-272-0623. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619